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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,440	02/27/2004	Veronique Ferrari	05725.0816-02	4114

22852 7590 08/24/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,440

Applicant(s)

FERRARI ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 114-145 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 114-145 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Receipt is acknowledged of preliminary amendment, IDS filed on 2/27/04. The preliminary amendment canceled claims 1-113 and added claims 114-145 have been added as per applicant's amendment dated 2/27/04. Claims 114-145 are pending in the application and the status of the application is as follows:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 114-145 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to a method of making mascara comprising including in said mascara polymer of formula I and **"when R<sup>4</sup> is a direct bond to R<sup>3</sup> or another R<sup>4</sup> so that the nitrogen atom to which both R<sup>3</sup> and R<sup>4</sup> are bonded forms a part of heterocyclic structure defined by R<sup>4</sup>-N- R<sup>3</sup>".** There is no description in the specification for heterocyclic ring systems. Therefore it is the position of the examiner that claims employing the above language at the point of novelty, such as applicants', neither provides those elements required practicing the inventions, nor "inform the public" during the life of the patent of the limits of the monopoly, asserted. The expression could encompass myriad of compounds and

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applicants claimed expression represents only an invitation to experiment regarding possible heterocyclic compounds.

2. Claims 119- 120, 127-128, 135-136, and 143-144 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

3. There is no support in the specification for “ at least one neutralizing agent”. There is no support in the specification for claims 120 and 128, which recite the limitation “ at least one vinylpyrrolidone polymer”. The support at page 29, line 10 is for “ vinylpyrrolidone copolymer”. Vinylpyrrolidone copolymer is formed from vinylpyrrolidone monomer another monomer (can be acrylate, methacrylate etc.) which polymerizes with the vinylpyrrolidone, where as vinylpyrrolidone polymer is former from vinylpyrrolidone monomer only.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 118, 126, 134, and 142 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The claims recite one compound and yet the claims are in Markush group format. Deletion of “ chosen from “ is suggested to overcome the above rejection.

***Claim Rejections - 35 USC § 103***

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 113-118, 121-126, 129-134, 137-141 and 145 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,783, 657 ('657); 6,402, 408('408) and 6, 214, 329 ('329).

The instant application is claiming a method of making a mascara comprising including in said mascara

1. At least one filler (species are kaolin, PTFE)
2. Polymer of formula I
3. Volatile solvent (species is isododecane)
4. Water
5. At least one coloring agent

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6. At least one preservative

7. Silica (another filler)

The patent '657 teaches polymer claimed in the instant application (ingredient 2) having gel consistency and these gels are useful in personal care products where in some self-supporting consistency is desired. See the abstract, see cols. 3-4 and see col.3, line 24 where the patent teaches that these polymers are useful in eye-makeup. The eye make up products are Mascara, eye shadow and eyeliner. The patent suggests the usefulness of this polymer in the eye-make up art. The patent at col.17, lines 25-30 teaches that this polymer can be combined with water, colorants and fillers and also teaches adding volatile solvent. The patent s '657 lines 35-47 teaches the mixing of ingredients and the patent '408 under examples also teaches the mixing of ingredients for eye shadow. The difference between the patent and the instant application is the patent does not teach the specific fillers or the specific volatile solvent or preservatives. The patent '408 also teaches the polymer useful as Mascara at col.7, line 50. See col.3 for the same polymer claimed, see the paragraph bridging cols 7-8 for the colorants. The patent '329 teaches Mascara product using specific volatile oil claimed at col.6, line 60 and at paragraph bridging cols. 8-9 the specific fillers claimed, and at col.9 pigments and under example 1 teaches preservatives which are the parabens.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '657or '408 by mixing the ingredients and use it as Mascara taught by both the patents along with water, volatile solvents, pigments, fillers and use the specific volatile solvents and specific filler of '329 expecting that the compositions are useful as Mascara. The motivation to combine the ingredients flows logically form the art for

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having been used in the same Mascara art. One of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success that the compositions which has the polymer has the structured property and when this product is applied to eyelashes the polymer imparts glossy and non-migrating benefit and the non-migrating benefit is useful to the consumer because when the Mascara is applied to eyelashes it does not stick to hands, clothing. This is prima facie case of obviousness.

10. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**JYOTHSNA A VENKAT**  
Primary Examiner  
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